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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/543,782 04/06/00 ZUCKER-FRANKLIN

D ZUCKER-FRANK

001444 HM12/0928  
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EXAMINER

WILDER, J.

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

09/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

Application No.

09/543,782

Applicant(s)

ZUCKER-FRANKLIN AND PANCAKE

Examiner

CB Wilder

Art Unit

1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Sep 14, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
  - (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b) ☐ they raise the issue of new matter. (See NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_  
\_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_  
\_\_\_\_\_
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1 and 2
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☐ Other: \_\_\_\_\_

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### ATTACHMENT TO ADVISORY ACTION

1. Applicant's amendment filed 9/14/2001 in Paper No. 9 will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with the requisite fees. However, the proposed amendments do not place claims 1 and 2 in condition for allowance and accordingly the rejection under 35 U.S.C. 102(b) is maintained and is discussed below.
2. Applicant traverses the rejection on the following grounds: Applicant argues that "claim 1 has been amended<sup>1</sup> to recite that the samples have not been tested for antibodies to HTLV-I or HTLV-II" and cites support for this amendment at page 16, lines 16-19 of the specification. Applicant further argues that "there is nothing in Zucker-Franklin et al. that discloses or suggest that the samples were tested for antibodies to HTLV-I or HTLV-II". Applicant request that a favorable action thereon be solicited.
3. The arguments have been thoroughly reviewed and considered but they are not found persuasive for the reason that follows: As noted in the Final office action of Paper No. 8, the courts have established that during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow (*In re Zeltz*, 893 F. 2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed Cir, 1989). In this case, the newly added claim language does not limit the claims in such a way to overcome the prior art because the reference of Zucker-Franklin et al. teach wherein the testing via Southern Blotting to determine a positive test is performed separately without input from the testing of antibodies to HTLV-I or HTLV-II (see prior Office action and Materials and Method section of reference). With regards to Applicant's arguments that Zucker-Franklin et al. do not disclose or


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suggest that the samples were tested for antibodies to HTLV-I or HTLV-II. The Examiner respectfully disagree because the reference clearly states that routine serology test showed 22.2% of the specimens positive for antibodies to HTLV and 48.1% positive for HTLV when tested by bimolecular means (page 6403, col. 2, lines 23-28). Therefore, the relevance of this argument is unclear to the claimed invention at hand. Nonetheless, the amendments and arguments are not sufficient to overcome the prior art rejection. Accordingly, the rejection under 35 U.S.C. 102(b) is maintained.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed the Group's receptionist whose telephone number is (703) 308-0196.

  
Cynthia B. Wilder, Ph.D.

September 25, 2001

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600

9/25/01